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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,894	10/22/2003	Richard Sapienza	1028-001K	6580

7590 04/22/2004

EXAMINER
GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
1755	

Alan B. Clement,
Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,894	SAPIENZA ET AL.	
	Examiner	Art Unit	
	Anthony J. Green	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 36-39 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 36-39 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 10/22/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Newly added claims 36-39 are not supported by the specification as originally filed. Applicant has tried in the arguments filed with the preliminary amendment to show where the support lies, however it is the position of the examiner that the portions of the specification the applicant is relying on for support, do not adequately provide proper support for the newly added claims. For instance, in claims 36 and 38 applicant points to numerous place in the specification for support of the limitation "3-60 weight % of mixtures of sugars" when applicant only has support for "about 5 to about 100 weight percent....preferably...from about 15 to about 80 weight percent". It is not seen as to how this provides support for the lower limit of the range now claimed, support only lies for a "about 5". Also in claims 36 and 38 applicant however in the specification provides support for the limitation of "5-35 weight % of chloride salt", the specification only states

a "method for reducing the amount of inorganic salt", nowhere is a range explicitly stated.

No support can be seen in the specification for the limitation of "wherein the molecular weight of each of the sugars is in the range of about 180-1638". While applicant points out where lower limit is taught, there is nothing in the specification that teaches or suggests the upper limit of the range namely "1638". It appears that applicant only provides support for a maximum of 1200. In claim 38, no support can be seen for the addition of a thickener in the amount of "0.15 to 10". There is no explicit recitation of the addition of a thickener. The portion pointed to by applicant does not positively state the addition of a thickener, it merely states that when the "carbohydrates are added to salts such as potassium acetate, the viscosity and wetting abilities of the anti-icing compound are increased". It is not seen as to how this provides support for the addition of a thickener to a sugar (carbohydrate) and a chloride salt. Accordingly based on the discussion above applicant has not provided proper support for the invention as now claimed in the preliminary amendment and it is considered to be new matter.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 36-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hartley et al (US Patent No. 6,582,622).

The reference teaches, in the claims, compositions that clearly encompasses that which is instantly claimed.

Applicant states that the instant claims are copied from the patent for the purpose of initiating an interference. It should be noted however, that no interference can declared until allowable subject matter is found.

4. Claims 36-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hartley et al (US Patent No. 6,599,440).

The reference teaches, in the claims, compositions that clearly encompasses that which is instantly claimed.

5. Claims 36-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hartley et al (US Patent No. 6,299,793).

The reference teaches, in the claims, compositions that clearly encompasses that which is instantly claimed.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 36-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-41 of copending Application No. 10/266,975. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the claims of the copending application would render obvious the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The claims of the copending application are encompassed by the instant claims.

Information Disclosure Statement

8. The remaining references have been considered however they are not seen to teach and/or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
April 19, 2004